

REMARKS

The application included claims 1-10, 12-24, and 31 prior to entering this response.

Claims 3 and 6 were indicated as including allowable subject matter

No claims are amended herein. No new matter is added.

The application remains with claims 1-10, 12-24, and 31 after entering this response.

Summary of Telephonic Examiner Interview

Applicant's undersigned attorney spoke with Examiner Kau on June 15, 2011 primarily to discuss the rejection of claims 1-10, 12-24, and 31 under 35 U.S.C. § 112, first paragraph. Examiner Kau alleged that the specification fails to unambiguously state that the reference pattern and the document are scanned at the same time, and instead alleged that the specification could be interpreted in different ways, e.g., at paragraph 0017 of the application as filed, as discussed below. Applicant's undersigned attorney argued that the language at paragraph 0017 would readily be understood by one of ordinary skill in the art to disclose the recited features, particularly when read in view of the specification as a whole. Examiner Kau invited Applicant to respond to the April 14, 2011 Office Action with a detailed argument that could be reconsidered with his supervisor. Applicant thanks Examiner Kau for his time and consideration.

Subject Matter Indicated as Allowable

The Examiner objected to claims 3 and 6 as being dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form. Applicant thanks the Examiner for the indication of allowable subject matter and the proposed amendment.

While Applicant appreciates that the Examiner has indicated that these claims are allowable, Applicant respectfully declines to rewrite claims 3 and 6 in independent form on the basis that the independent claims 1 and 4, upon which they depend, are themselves allowable, as discussed further below.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 1-10, 12-24, and 31 under 35 U.S.C. § 112, first paragraph. The rejection is traversed.

The claims were rejected as allegedly not having support for the recited features, such as “wherein the reference pattern and the document are scanned at the same time”, as recited by claim 10, (page 4 of the April 18, 2011 Office Action). Applicant respectfully disagrees.

The language recited by the rejected claims finds support variously throughout the specification, for example at paragraph 0017 which states “Also referring to FIG. 2 at the same time, as shown in FIG. 3, during step 302 multiple scanning lines are used first to scan a document 212 and a longitudinal black and white pattern 218.” Applicant respectfully submits that one of ordinary skill in the art would appreciate that both the document 212 and the calibration pattern 218 illustrated in FIG. 2 may be scanned at the same time.

A conventional scanner is illustrated in FIG. 1 and described in Applicant’s specification as including a “transverse complete white pattern 116 (that) is located on an inner wall of the top 108 near an end of the scanning platform 110 and is used to allow the scanner 100 to perform a correction on the image before the chassis 114 starts to scan the document” (paragraph 0003 of the application as filed, emphasis added). The description of the conventional scanner continues at paragraph 0004 by stating that “the intense light needed for the scanning operation and the scattering light in the environment during the scanning operation can affect the gray level value of the image after the chassis 114 scans the document... (such that) the obtained gray level value of the image cannot be adjusted according to the correctional gray level value.”

In contrast, the summary of the invention (paragraph 0005) describes “comparing the correctional gray level value of complete black or complete white... (so that) the image brightness obtained by the scanner is adjusted. At the same time, the light brightness errors that occur due to the light intensity needed by the scanning operation or due to the disturbance created by light scattering in the environment can be compensated” (emphasis added).

With respect to FIG. 2, the specification further describes that “the longitudinal black and white pattern 218 is specifically located on an inner wall of the top 208 on a side near the scanning platform 210 to allow the scanner 200 to perform image brightness compensation when the chassis 214 scans the document 212 (paragraph 0016 of the application as filed, emphasis added). In other words, the location of the pattern 218 on the side near the scanning platform

210 allows for compensation of the image brightness to occur when the document 212 is being scanned. This is contrasted with the conventional scanner illustrated in FIG. 1 in which the pattern 116 is scanned before the document 112, such that any image brightness due to scanning the document 112 would not have any effect when the pattern 116 is scanned by the conventional scanner, as described at paragraphs 0003 and 0004 of the application as filed, since the two conventional scanning operations are separated by both time and space.

Claim 19 recites, in part, an *apparatus comprising: means for scanning a document and a calibration pattern at the same time along a scanning path.*

Even assuming, arguendo, that the application fails to provide explicit support for the recited claim language, Applicant respectfully submits that according to MPEP 2181,

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function... The Federal Circuit concluded that the title of the article in the specification may, by itself, be sufficient to indicate to one skilled in the art the precise structure of the means for performing the recited function... The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. (Emphasis added).

Assuming the Examiner's basis for rejecting claim 19 is that the recited features comprising *means for scanning a document and a calibration pattern at the same time along a scanning path* is not explicitly identified in the specification, Applicant respectfully submits that it is sufficient if they are implicitly or inherently disclosed, as provided in MPEP 2181, and for the reasons provided above. Accordingly, withdrawal of the rejection of claims 1-10, 12-24, and 31 is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 4, 5, 7-10, 12-24, and 31 under 35 U.S.C. § 103(a) over Su (U.S. Patent 6,233,011) and variously in view of Irving *et al.* (U.S. Patent 6,658,164), Lee *et al.* (U.S. Patent 6,178,015), Rykowski *et al.* (U.S. Patent 6,975,775), and Liu (U.S. Patent 7,492,488).

The rejection is traversed.

In the Amendment dated February 16, 2011 Applicant provided a detailed discussion for why the rejection of the pending claims should be withdrawn. In the Office Action dated April 18, 2011 the Examiner replied to Applicant's arguments by stating that "the original specification does not provide any supports to the above amended feature(s)"... and that because "of the new grounds of rejection, the previous non-final Action is withdrawn" (page 3, Examiner replies).

In so far as the rejection under section 103 is maintained, Applicant refers the Examiner's attention to the remarks and arguments provided in the February 16, 2011 Amendment. The previous arguments made by the Applicant are not repeated herein, but are maintained, and may be relied upon during appeal, if necessary. Withdrawal of the rejection of claims 1, 2, 4, 5, 7-10, 12-24, and 31 is respectfully requested.

Any statements made by the Examiner that are not addressed by the Applicant do not necessarily constitute agreement by the Applicant. In some cases, the Applicant may have amended or argued the independent claims thereby obviating grounds for rejection of the dependent claims.

CONCLUSION

For the foregoing reasons, the Applicant respectfully requests reconsideration and allowance of the present application. The Examiner is encouraged to telephone the undersigned at (503) 546-1812 if it appears that an interview would be helpful in advancing the case.

Customer No. 73552

Respectfully submitted,

STOLOWITZ FORD COWGER LLP



Bryan D. Kirkpatrick
Registration No. 53,135

STOLOWITZ FORD COWGER LLP
621 SW Morrison Street, Suite 600
Portland, OR 97205
Telephone: 503-224-2170
Fax: 503-224-2084
Email: docket@stofoco.com